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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,404	02/21/2002	Darren T. Castro	56206US002	1561

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 10/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,404

Applicant(s)

CASTRO ET AL.

Examiner

Michael A Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30, 32 and 44-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30, 32 and 44-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 25, 26 and 27-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25 and 27 are indefinite because the phrase “the plurality of abrasive particles” lacks antecedent basis since a “plurality of abrasive particles” has not been **literally** defined before.

Claims 29 and 30 are indefinite as to the phrase “said abrasive particles have a specified nominal grade is selected from” because this phrase does not make sense. In addition, claim 27 already defines that the abrasive particles have a specified nominal grade.

Claims 26 and 28 are indefinite because they depend on an indefinite claim.

PREVIOUS REJECTIONS:

Claims 1, 12-14, 25, 27-30, 45 and 48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Amero for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 18-24, 26, 32, 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amero in view of Monroe et al. (671) and Johnson et al. (067) for the same reasons set forth in the previous office action which are incorporated herein by reference.

NEW REJECTIONS:

Claims 1-25, 27-30, 32 and 48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 705,803.

The EP reference teaches in the abstract, page 3, line 54-page 4, line 15, page 6, line 3, page 19, line 34-35, the examples and the claims, a grinding part comprising a resin (i.e. binder-see examples) and a sintered zirconia material (having a specified size) which comprises stabilized zirconia (claimed stabilizers), alumina, silica, and other components. The reference defines amount for the components which reads on the claimed amounts.

The reference teaches a grinding part which comprises the claimed components and it is the examiners position that this reads on an abrasive article because an abrasive article is a grinding material (i.e. part), thus anticipating the instant claims. The reference also teaches the inclusion of stabilizers and other oxides which read on the claimed additional components. The amounts, when calculated in terms of weight percent, also encompass the claimed amounts in the absence of any evidence showing the contrary. The reference also teaches a size which reads on the claimed specified nominal grade. Finally, with respect to claim 48, since the reference teaches a grinding part (resin and sintered particles), the claimed grinding method is inherent in the reference because this is the way to grind a material (i.e. a grinding part is used to grind a material). In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention in the absence of any evidence showing the contrary. Assuming *arguendo* about the "abrasive article" limitation, no distinction is seen to exist because the composition is the same irrespective of what it is called.

Applicant's arguments filed 8/21/03 have been fully considered but they are not persuasive.

Applicants argue that Amero does not teach the claimed invention because the amount of zirconia is outside the claimed range. The examiner disagrees because the reference clearly teaches that the zirconia content is “**about** 60%” and this reads on at “least 60%”. In addition, since the term “**about**” is used in the reference, no patentable distinction is seen to exist in the absence of any critical evidence showing the contrary because “about” **permits some tolerance**, *In re Ayers*, 154 F 2d 182, 69 USPQ 109. Applicants also argue the limitations of claim 2-7 but these claims have not been rejected.

Applicants fail to argue the combination of Amero in view of Monroe et al. (671) and Johnson et al. (067), thus no comment is necessary.

This action is not made final in view of the new rejection and since original claim 31 (now canceled) contained the subject matter of the pending claims (i.e. claim 1 at least).

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

“A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)”. In addition, “A

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reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

"A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

The additional references cited on the 1449 have been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

Any foreign language documents submitted by applicant has been considered to the extent of the short explanation of significance, English abstract or English equivalent, if appropriate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The examiner can be normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Amendments can also be sent by fax to the numbers set forth below:

For after final amendments, the fax number is (703) 872-9311;

For non-final amendments, the fax number is 703 872-9310.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661

Michael Marcheschi

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4/03

MICHAEL MARCHESCHI
PRIMARY EXAMINER